

REMARKS

Claims 1-33 and 47-48 are pending in this Application. By this Amendment, claims 1, 14, 21, 22 and 33 have been amended. No new matter is added. Claims 12 and 13 have been cancelled without prejudice to, or disclaimer, of the subject matter recited therein. Reconsideration in view of the above amendments and the following remarks is respectfully requested.

Formal Matters

The Office Action rejects claim 33 under 35 U.S.C. §101 alleging that the claimed invention is directed to non-statutory subject matter. The Applicants traverse this rejection, as follows.

Regarding claim 33, the Office Action states that “the claim is directed to a signal directly or indirectly by claiming a *computer usable medium* and the Specification . . . recites evidence where the medium is defined as a ‘signals’ . . . In that event, the claim is directed to a form of energy which at present the office feels does not fall within at least one of the four enumerated categories of patentable subject matter recited in section 101” (see Office Action, pages 2-3).

It is respectfully submitted that claim 33 does not recite or mention a “signal.” Claim 33 is directed to a “computer program product comprising a computer usable medium having control logic stored therein for causing a computer to provide interactive assistance with populating an automated document.” It is improper to import claim limitations from the specification. See M.P.E.P. section 2111.01. “Though understanding the claim language may be aided by explanations contained in the

written description, it is important not to import into a claim limitations that are not part of the claim. For example, a particular embodiment appearing in the written description may not be read into the claim when the claim language is broader than the embodiment.” See *Superguide Corp. v. DirectTV Enterprises, Inc.*, 358 F.3d 870 (Fed. Cir. 2004).

Furthermore, although the Court of Appeals for the Federal Circuit has held that a “signal, standing alone” is not patentable subject matter, the court was careful to distinguish claims directed to “a storage medium holding the resulting signals,” which were allowed by the PTO. See *In re Petrus A.C.M. Nijten*, 500 F.3d 1346 (Fed. Cir. 2007).

Thus, it is respectfully submitted that claim 33, directed to a “computer program product comprising a computer usable medium having control logic stored therein for causing a computer to provide interactive assistance with populating an automated document,” which is an article of manufacture, contains patentable subject matter under 35 U.S.C. §101. Accordingly, the Applicants respectfully request that the Examiner withdraw the rejection.

Claims Define Patentable Subject Matter

The Office Action rejects claims 1-33 and 47-48 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,270,351 to Roper in view of U.S. Patent No. 6,912,502 to Buddle et al. To the extent that these rejections remain applicable to the claims, as amended, the Applicant respectfully traverses these rejections, as follows.

The Applicants submit that Roper and Buddle, either individually or in combination, fail to disclose or suggest a method for providing interactive assistance with populating an automated document that includes at least one field, the method including at least prompting for a response for each of the at least one field, the prompting varying based on the prioritization of each of the at least one field; varying a color of each of the at least one field based on the prioritization, as recited in amended claim 1.

The Office Action submits, on page 10, that Roper, in Figs. 7 and 8 and the associated text, shows variably highlighting each of the at least one field in a color, the color varying with the prioritization of each of the at least one field. Roper, in Figs. 7 and 8 and col. 9, lines 6-27, shows an initial referral screen where the information is automatically populated. However, Roper does not disclose or suggest "varying a color of each of the at least one field based on the prioritization," as recited in claim 1.

For at least the above reasons, the Applicants submit that claim 1 is allowable over the cited references. As claim 1 is allowable, the Applicants submit that claims 2-11 and 14-20, which depend from allowable claim 1, are likewise allowable over the cited references, as well as for the additional features they recite.

For similar reasons to those discussed with regard to allowable claim 1, the Applicants submit that amended claims 21-22 and 33 are allowable over the cited references. As amended claims 21-22 and 33 are allowable over the cited references, the Applicants submit that claims 23-32 and 47-48, which depend from allowable claims 21-22 and 23, respectively, are likewise allowable over the cited references, as well as for the additional features they recite.

Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-11, 14-33 and 47-48 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number set forth below.

In the event this paper is not considered to be timely filed, the Applicant hereby petitions for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, referencing Attorney Dkt. No. 026063-00014.

Respectfully submitted,



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